

AF

**PATENT**  
Attorney Docket No. 187831  
Client Reference No. 116598.01

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Lawton et al.

Art Unit: 2176

Application No. 09/260,837

Examiner: Singh, Rachna

Filed: March 2, 1999

For: METHOD AND SYSTEM FOR BROWSING  
A LOW-RESOLUTION IMAGE

**TRANSMITTAL OF  
APPELLANTS' APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR 1.192, appellants hereby submit Appellants' Brief on Appeal in triplicate.

The items checked below are appropriate:

**1. Status of Appellants**

This application is on behalf of ☒ other than a small entity or ☐ a small entity.

**2. Fee for Filing Brief on Appeal**

Pursuant to 37 CFR 1.17(c), the fee for filing the Brief on Appeal is for: ☒ other than a small entity or ☐ a small entity.

**Brief Fee Due** \$330.00

**3. Oral Hearing**

☐ Appellants request an oral hearing in accordance with 37 CFR 1.194.

**CERTIFICATE OF MAILING**

I hereby certify that this document (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Date: September 16, 2004

*Susan Mats*

09/22/2004 YPOLITE1 00000001 121216 09260837

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01 FC:1251 110.00 DA

In re Appln. of Lawton et al.  
Application No. 09/260,837

**4. Extension of Time**

- ☒ Appellants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is \$110.00.
- ☐ Appellants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that appellants have inadvertently overlooked the need for a petition and fee for extension of time.

**Extension fee due with this request: \$110.00**

**5. Total Fee Due**

The total fee due is:

Brief on Appeal Fee	\$330.00
Request for Oral Hearing	\$ 0.00
Extension Fee (if any)	\$110.00

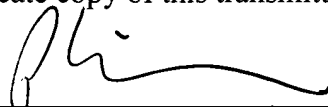
**Total Fee Due: \$440.00**

**6. Fee Payment**

- ☐ Attached is a check in the sum of \$ .
- ☒ Charge Account No. 12-1216 the sum of \$440.00. A duplicate of this transmittal is attached.

**7. Fee Deficiency**

- ☒ If any additional fee is required in connection with this communication, charge Account No. 12-1216. A duplicate copy of this transmittal is attached.

  
\_\_\_\_\_  
Phillip M. Pippenger, Reg. No. 46,055  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson Avenue  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

Date: September 16, 2004



**PATENT**  
Attorney Docket No. 187831  
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In re Application of: Lawton, et al.

Application No. 09/260,837

Filed: March 2, 1999

Art Unit: 2176

Examiner: Singh, Rachna

For: METHOD AND SYSTEM FOR  
BROWSING A LOW-RESOLUTION  
IMAGE

CERTIFICATE OF MAILING

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Date: 9/16/04 Susan Metz

**APPELLANTS' BRIEF ON APPEAL**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In support of the appeal from the rejection dated December 16, 2003,

Appellants now submit their Brief.

**(1) Real Party In Interest**

The patent application that is the subject of this appeal is assigned to Microsoft

Corporation.

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**(2) Related Appeals and Interferences**

There are no appeals or interferences that are related to this appeal.

**(3) Status of Claims**

Claims 1 and 4-30 are currently pending in this application, and are at issue herein.

Copies of the pending claims are attached at the Appendix.

**(4) Status of Amendments**

There are no outstanding amendments in this application.

**(5) Summary of Invention**

The invention pertains generally to a system for conveniently and efficiently retrieving information from a document without incurring the cost of downloading and/or displaying a high-resolution version of the document. The system includes a document model comprising data structures that represent the components within the document, as well as a thumbnail image registered with the document model. Specification at page 4, lines 4-7, see also Figure 2. The registration between the thumbnail image and the document model is accomplished by mapping selected coordinates within the thumbnail image to data structures of the document model. Specification at page 4, lines 7-10, see also Figure 2. A user can interact with the thumbnail image coordinates to retrieve information from the document as a function of the component(s) mapped to those coordinates. Specification at page 4, lines 10-13. The information so retrieved may be streamed to a word-at-a-time display while the thumbnail view is modified to provide a user with an indication of context. Specification at page 4, lines 13-17, see also Figure 6. The

system of the invention thus allows a user to conveniently interact with a low-resolution thumbnail image to extract detailed information from a document without having to download/display the original full-resolution image of the document. Specification at page 4, lines 18-23.

#### **(6) Issues**

The first issue presented in this appeal is whether claims 1, 7-14, 18, and 22-23 are obvious under 35 U.S.C. §103(a) over W3C, “Document Object Level 1 Specification” (hereinafter “W3C”) in view of “Awareness Through Fisheye Views In Relaxed-WYSIWIS Groupware,” GroupLab of the university of Calgary (hereinafter “GroupLab”). With respect to this issue, a more specific question presented is whether the examiner has made out a prima facie case of obviousness of these claims where there is no suggestion or motivation to combine the teachings of the cited references in the asserted manner and where there is no reasonable expectation of success from such combination.

The second issue presented in this appeal is whether claims 4 and 5 are obvious under 35 U.S.C. §103(a) over W3C in view of GroupLab, further in view of Scalable Vector Graphics Specification (hereinafter “SVG”). With respect to this issue, a more specific question presented is whether the examiner has made out a prima facie case of obviousness of these claims where there is no suggestion or motivation to combine the teachings of the cited references in the asserted manner and where there is no reasonable expectation of success from such combination.

The third issue presented in this appeal is whether claims 6, 15-17, 19-21, 24-30 are obvious under 35 U.S.C. §103(a) over W3C in view of GroupLab, further in view of Edupage Newsletter, February 4, 1997 (hereinafter “Edupage”). With respect to this issue, a more specific

question presented is whether the examiner has made out a prima facie case of obviousness of these claims where there is no suggestion or motivation to combine the teachings of the cited references in the asserted manner and where there is no reasonable expectation of success from such combination.

#### **(7) Grouping of Claims**

Applicants respectfully submit that the claims of this application do not stand or fall together. Specifically, the Applicants respectfully state that claims 1, 7-14, 18, and 22-23 (Group 1) stand or fall together, that claims 4 and 5 (Group 2) stand or fall together, and that claims 6, 15-17, 19-21, and 24-30 (Group 3) stand or fall together.

The foregoing groupings of claims are appropriate under 37 C.F.R. § 1.192(c)(7) since, *inter alia*, each of Groups 1, 2, and 3 is subjected to a different ground of rejection, as will be apparent from the argument presented herein below. Applicants have not attempted to differentiate claims within these groups.

#### **(8) Argument**

A *prima facie* case of obviousness requires a suggestion or motivation, either in the cited references themselves or in the demonstrated knowledge generally available to one of ordinary skill in the art at the time the application was filed, to combine reference teachings in the asserted manner. Moreover, the art must demonstrate a reasonable expectation of success in the combination. *See*, Manual of Patent Examining Procedure §2143. The teaching or suggestion to make the claimed combination/modification and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In summary, the rejections at issue are made under §103, and yet the requirements for such have not been followed. There is simply no motivation to combine the references as asserted, nor any expectation of success in doing so. When asked for clarification, the Office essentially responded that the references are combinable because they have some mutual feature, something in common. Applicants note, however, that this is not an approved or proper test for combinability. It is respectfully submitted that no proper combination of references teaches the elements of the pending claims, and it is requested that the claims be favorably reconsidered.

**a. A Prima Facie Case of Obviousness Has Not Been Presented With Respect to the Claims of Group 1**

Group 1 comprises claims 1, 7-14, 18, and 22-23. Copies of the claims are included at the Appendix. Each claim continues to be rejected under §103 and not § 102, and as such there is no disagreement as to the fact that the invention of each claim is not itself described in whole in any piece of prior art.

As previously noted, the law imposes strict and clear requirements governing the Office's combining of references to reject any claim. In particular, there must be a suggestion or motivation originating *in the art* to combine the references in the asserted manner. MPEP §2143. There must also be a reasonable expectation of success, again found in the art, with respect to the asserted combination. *Id.*

With respect to the claims of Group 1, there is no reason found in the art to make the asserted combination of W3C and GroupLab. The given rationale that "it would have been obvious ... to combine W3C's DOM [document object model] with GroupLab's thumbnail registration with a document since mapping coordinates to a data structure and thumbnails provide a means to link to another document" is simply an assertion that one of skill in the art

*could* combine the known art to arrive at the invention. However, the relevant legal standard requires a demonstrated motivation, not simply a demonstrated *ability*. The “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP §2143.01 (Emphasis in original).

In the present case, the Office is simply asserting that all the *pieces* of the invention were known and that one of skill in the art would thus have been able to combine them to make the invention. The Office has not indicated that the GroupLab technology was somehow deficient or otherwise in need of modification from the perspective of one of skill in the art at that time. Moreover, the assertion that the combination is desirable “since mapping coordinates to a data structure and thumbnails provide a means to link to another document” implies that there was no linking in the GroupLab technique, which would seem to contradict the Office’s other characterizations of GroupLab. *See* Final Office Action at p. 11 (...GroupLab’s thumbnail registration with a document...Both thumbnails and DOM provide users with the ability to link to another document...”)

Thus the Office has presented an alleged motivation to combine the references, however the alleged motivation is a conclusory statement of ability and not motivation, and is not consistent with the references or the Office’s characterizations thereof. In response to applicants’ arguments, the Office has addressed the combination of W3C and GroupLab as follows:

In this case, W3C disclosure teaches that XML applications provide for the ability to link to a portion of a document from a document model. *See* abstract. Furthermore, it was well known in the art at the time of the invention to provide reduced images (thumbnails) from which a user could select coordinates linking to the larger document, as taught in GroupLab’s thumbnail registration with a document. ***Both thumbnails and DOM provide users with the ability to link to another document by providing a “mapping” to a data structure. Thus it would have been obvious*** to one of ordinary skill in the art at the time of



the invention to combine the features taught by GroupLab ... with W3C's teachings... since it provides the user with the ability to communicate with another document.

...[G]iven that these two features [(DOM and mapping thumbnail to document)] were well known in the art at the time as a means for linking to a document, it would have been obvious ... to combine the two references as the mapping of a DOM or structure of an XML document would be the next logical step in representing the structure of a document in a reduced image format since it already took into account the structure of a document.

See Final Office Action at p. 11-12.

The primary thrust of the Office's reasoning is that since GroupLab and DOM have something in common ("..a 'mapping' to a data structure..."), then they are combinable. That is not the test for combinability. The MPEP clearly sets forth an entirely different test, one that requires that an actual motivation or suggestion be found in the art. The fact that the teachings of two references have a common element says nothing about a motivation to combine. If the "something in common" rule were to replace the actual test for combinability, we could combine a horse with a cave (since both have mouths), or a clock with a cliff (since both have faces), or a snake with a condenser (since both have coils). As the law currently stands, however, the "something in common" rule does not meet the standards set forth by the MPEP, and the mere existence of common elements across disparate references does not amount to a motivation to one of skill in the art to combine the teachings in questions.

Moreover, the asserted similarity among the references in the stated regard actually contradicts the alleged motivation to combine the references as noted above. The action states that one would be motivated to combine the references since "it provides the user with the ability to communicate with another document." However, the action already said that both references teach that feature ("**Both** thumbnails and DOM provide users with the ability to link to another document..."). If the stated beneficial result of combining the references is already provided by each reference independently, why would the skilled artisan be motivated to combine the

references? In other words, there is no motivation to combine references if the result would give you a feature that you already have in either reference alone.

Addressing a subsequent portion of the Office's response, this paragraph provides an alternative but similarly erroneous justification for the asserted combination. In summary, this clause says that "since it [(the reduced image format of GroupLab?)] already took into account the structure of a document" then "it would have been obvious ... to combine the two references." *See* Final Office Action at page 12. Again, this seems to be the "something in common" doctrine at work; i.e., if both references take into account document structure, then the references must be automatically combinable. It bears repeating that this is *not* the law, and it does not comport with the requirements set forth in the MPEP regarding when references are properly combinable.

It is thus respectfully asserted that a prima facie case of obviousness has not been shown, and removal of the outstanding grounds of rejection, and allowance of the claims of Group 1 are respectfully solicited.

**b. A Prima Facie Case of Obviousness Has Not Been Presented With Respect to the Claims of Group 2**

Group 2 comprises claims 4 and 5, both of which stand rejected as obvious over the combination of GroupLabs and W3C, further in view of the SVG. Copies of the claims are included at the Appendix. With respect to dependent claims 4 and 5, the Office justifies combining SVG with W3C and GroupLab by stating that "Since XML is a structured document, it would have made sense to one of ordinary skill in the art at the time the invention was made to incorporate images and vector graphics in a system for registering a thumbnail with a document since the technology for including images and vector graphics in structured documents already existed." The action itself thus clearly demonstrates that the Office is citing not an actual

*motivation* to combine, but simply an *ability* to combine – it “would have made sense” (i.e. the artisan could have done it) since the “technology” (i.e. the ability) existed.

As noted above, the law is clear in its requirement that a *prima facie* showing of obviousness requires a showing of motivation to combine, and simple ability to combine is not enough. *See* MPEP §2143.01 (“...mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”) (Emphasis in original).

It is thus respectfully asserted that a *prima facie* case of obviousness has not been shown, and removal of the outstanding grounds of rejection, and allowance of the claims of Group 2 are respectfully solicited.

**c. A Prima Facie Case of Obviousness Has Not Been Presented With Respect to the Claims of Group 3**

Group 3 comprises claims 6, 15-17, 19-21, and 24-30. Copies of the claims are included at the Appendix.

With respect to claims 6 and 15 (claims 16-17 depend from claim 15, and claims 19-21 are rejected on the same rationale), the action justifies combining Edupage with W3C and GroupLab by simply stating: “Tenax discloses an Applet for streaming the *text* of a webpages document...It would have been obvious ...to incorporate the applet [for word at a time display] with the system described jointly by W3C and GroupLab since the system represents a document model consisting of *text* and other components registered with a thumbnail.” (Emphasis added). Thus, the Office’s statement of motivation is that since the applet works with text and the combination of W3C and GroupLab works with text, the former can be combined with the latter.

However, an allegation that art can be combined has no bearing on whether the artisan would have made the combination; the law requires not just evidence of ability, but also evidence of motivation. See MPEP §2143.01 (“mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”)(Emphasis in original). Moreover, as discussed above, the mere existence of a common element across references is not a prima facie suggestion to combine those references.

With respect to claim 24 (the subsequent claims in Group 3 depend from claim 24), the action justifies combining Edupage with W3C and GroupLab by simply stating: “It would have been obvious ...to incorporate ‘word at a time display’ ...since it was well known ...to use the applet to increase reading speeds.” This is simply a statement that the Edupage art describes a useful technique; however, almost every piece of art in existence at least purports to describe a useful technique. Surely that alone is not enough to start combining references. Simply put, there needs to be, in the art, some *suggestion* to combine, and none of the references combined here demonstrate such a suggestion.

It is thus respectfully asserted that a prima facie case of obviousness has not been shown, and removal of the outstanding grounds of rejection and allowance of the claims of Group 3 are respectfully solicited.

**CONCLUSION: CLAIMS 1 AND 4-30 ARE IN CONDITION FOR ALLOWANCE**

In view of the above, the Applicants respectfully submit that claims 1 and 4-30 are in condition for allowance. Consideration of this Appeal, removal of the outstanding grounds of rejection, and allowance of claims 1 and 4-30 are respectfully solicited.

Respectfully submitted,



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Phillip M. Pippenger, Reg. No. 46,055  
One of the Attorneys for Applicant(s)  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

Date: September 16, 2004

## **APPENDIX: Claims at Issue**

1. A system for linking to a document, comprising:  
a document model, representative of the document, having a plurality of data structures representative of components within the document, wherein the document is an XML document;  
and  
a thumbnail image registered with the document model using XML tags of the XML document such that selected coordinates within the thumbnail image are each mapped to a data structure selected from the plurality of data structures.
4. The system as recited in claim 1, wherein the components comprise images.
5. The system as recited in claim 4, wherein the images comprise vector graphics.
6. The system as recited in claim 1, further comprising a word-at-a-time display associated with the thumbnail image for displaying the data represented by selected components from the document model, the components selected in response to interaction with the thumbnail.
7. The system as recited in claim 1, wherein the components are individually addressable.
8. A method for registering a low-resolution thumbnail image with a document model having a plurality of data structures representative of components within a document, the method comprising the steps of:  
creating a full-sized bitmap image representative of the document;  
identifying coordinates within the full-sized bitmap image;  
mapping selected coordinates within the full-sized bitmap image to components selected from the document model, wherein the document model comprises hierarchically related model components, and whereby hierarchically related document components are associated with corresponding hierarchically related model components; and  
reducing the full-sized bitmap image into the low-resolution thumbnail image.

9. The method as recited in claim 8, wherein the document is a text document and the components comprise one or more page components, textual block components, textual line components and word components.
10. The method as recited in claim 8, wherein the document is an XML document.
11. The method as recited in claim 8, wherein the step of mapping further comprises the step of providing an address link to a computer storage location between the coordinates and each component selected from the document model mapped to the coordinates.
12. The method as recited in claim 8, wherein the step of identifying further comprises the step of identifying coordinates that define a unit of text.
13. The method as recited in claim 8, wherein the step of reducing further comprises the step of sub-sampling the full-sized bitmap image.
14. A method for retrieving information from a document represented by a thumbnail image having coordinates registered with components selected from a document model having hierarchically related model components representative of hierarchically related components of the document, the method comprising the steps of:
  - sensing the position of a cursor over the thumbnail image;
  - determining the coordinates within the thumbnail image corresponding to the sensed cursor position;
  - determining a component within the hierarchically related model components corresponding to the coordinates within the thumbnail image corresponding to the sensed cursor position; and
  - retrieving data from the document corresponding to the determined component from the document model corresponding to the determined coordinates.

15. The method as recited in claim 14, further comprising the step of streaming to a word-at-a-time display the data retrieved from the document.

16. The method as recited in claim 15, further comprising the step of altering the appearance of the thumbnail image to provide an indication of the information streamed to the word-at-a-time display.

17. The method as recited in claim 15, wherein the step of streaming is continued until a delimiter reflecting a unit of document organization is reached.

18. A computer-readable medium comprising instructions for retrieving information from a document represented by a thumbnail image having coordinates registered with components selected from a document model comprised of hierarchically related model components representative of hierarchically related components of the document, the instructions performing the steps of:

- sensing the position of a cursor over the thumbnail image;
- determining the coordinates within the thumbnail image corresponding to the sensed cursor position;
- determining a component within the hierarchically related model components corresponding to the coordinates within the thumbnail image corresponding to the sensed cursor position; and
- retrieving information from the document corresponding to the determined component from the document model corresponding to the determined coordinates.

19. The computer-readable medium as recited in claim 18, further comprising instructions for performing the step of streaming to a word-at-a-time display the information retrieved from the document.



20. The computer-readable medium as recited in claim 19, further comprising instructions for performing the step of altering the appearance of the thumbnail image to provide an indication of the information streamed to the word-at-a-time display.
21. The computer-readable medium as recited in claim 19, wherein the step of streaming is continued until a delimiter reflecting a unit of document organization is reached.
22. A computer-readable medium comprising instructions for registering a low-resolution thumbnail image with a document model having a plurality of data structures representative of components within a document, the instructions performing the steps of:
- identifying coordinates within a full-sized bitmap image;
  - mapping selected coordinates within the full-sized bitmap image to components selected from the document model, wherein the document model comprises hierarchically related model components, and whereby hierarchically related document components are associated with corresponding hierarchically related model components; and
  - reducing the full-sized bitmap image into the low-resolution thumbnail image.
23. The computer-readable medium as recited in claim 22, wherein the step of identifying further comprises identifying coordinates that define a unit of text.
24. A hand-held computer, comprising:
- a memory adapted to store thereon a document model, representative of a document, the document model having a plurality of hierarchically related data structures representative of hierarchically related components within the document; and
  - a display adapted to display a thumbnail image registered with the document model and a word-at-a-time display;
- wherein the thumbnail image is registered with the document model such that selected coordinates within the thumbnail image are each mapped to a data structure selected from the plurality of hierarchically related data structures; and wherein the word-at-a-time display is

adapted to display data represented by components selected from the document model in response to interaction with the thumbnail.

25. The hand-held computer as recited in claim 24, wherein the document is a HTML document.

26. The hand-held computer as recited in claim 24, wherein the document model comprises one or more hyperlinks and the word-at-a-time display is adapted to display hyperlinks in a manner that attracts the visual attention of a user.

27. The hand-held computer as recited in claim 25, wherein the manner that attracts the visual attention of the user is flashing the hyperlink in the word-at-a-time display.

28. The hand-held computer as recited in claim 24, wherein the thumbnail image is adapted to track the context of information streamed to the word-at-a-time display.

29. The hand-held computer as recited in claim 28, wherein the document comprises one or more hyperlinks and the thumbnail image is adapted to display the context of streamed hyperlinks in a manner adapted to visually attract a user.

30. The hand-held computer as recited in claim 29, wherein the manner adapted to visually attract the user comprises flashing a portion of the thumbnail image corresponding to the streamed hyperlink.